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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,796	11/20/2001	Michael Y. Zhang	ACSC 59931 (1987D)	1816
24201	7590	07/12/2007		
FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045			EXAMINER	
			BUI, VY Q	
			ART UNIT	PAPER NUMBER
			3734	
			MAIL DATE	DELIVERY MODE
			07/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/989,796

Applicant(s)

ZHANG ET AL.

Examiner

Vy Q. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/2/07.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26 and 28-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26 and 28-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Specification***

The amendment filed 2/14/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Claim 1 recites "the inflated configuration outer diameter at the inflation pressure at inflation conditions otherwise the same but as part of a catheter system". There is no disclosure in the specification about the outer diameter at "**the same inflation conditions but as part of a catheter system**". The original specification is silent regarding the inflation conditions of the balloon, such as temperature or pressure of the balloon, as part of a catheter system. Without any specific information about the inflation conditions, for example, the temperature and inflation pressure of the balloon, one of ordinary skill in the art would understand that the inflation conditions, such as temperature or pressure of the balloon, may not have the same values.

Because the original specification does not clearly specify the inflation conditions, the explanation or interpretation of the Applicant in the Remarks of paper 7/2/2007 is considered only as a suggestion from the Applicant to a reader of the newly amended claim, and therefore is also considered as a new subject matter introduced into claim 26.

The shrinkage percentage is not clearly defined in the specification and thus the claimed shrinkage percentage in claim 1 is not clearly defined either. It would be proper to consider that

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the present claimed invention therefore is not defined over WANG et al. (5,556,383) as presented below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26, 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by WANG et al. (5,556,383).

Notice that as mentioned above, the shrinkage percentage is not clearly defined in the specification and thus the claimed shrinkage percentage in claim 1 is not clearly defined either. Therefore, Wang reference is still applicable to the claimed invention. Wang (for example 1 and table 1) discloses a polymeric balloon having a radial shrinkage less than 6% and a length of about 2cm. It appears that at least the condition (temperature of the balloon as a part of a catheter system) for determining the shrinkage percentage in this present invention is not clearly defined in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30-33, 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over WANG et al. (5,556,383).

As to claims 30-32, WANG (example 1 and table 1) discloses a polymeric balloon having substantial all structural limitation as recited in the claims, except for the axial growth is less than 6% or 10%. However, WANG discloses radial shrinkage less than 6% in a radial direction and the material of the balloon is substantially homogenous, therefore, it would be reasonable to expect the growth percentage in a same order to the radial shrinkage or less than 6% or 10%.

As to claim 33, WANG (example 1 and table 1) discloses a polymeric balloon of pebax (col. 5, lines 51) having substantial all structural limitation as recited in the claims, except for the balloon is made at least in part of a polyurethane. However, pebax and polyurethane are well-known low compliant polymeric materials suitable for manufacturing balloon in a balloon catheter. It would have been obvious to one of ordinary skill in the art at the time of the invention to have polyurethane as a material to make WANG balloon, as this configuration would guarantee a low compliant balloon with low shrinkage percentage.

As to claims 34-35, WANG (example 1 and table 1) discloses a polymeric balloon of pebax (col. 5, lines 51) having substantial all structural limitation as recited in the claims, except for length of the balloon as recited in the claims. However, the length of a balloon is mostly dependent on the length of a stenosis, which varies dependent on an individual patient. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to specify the length of the balloon as recited in the claims so that different lengths of the balloons are available for different individual patients.

As to claims 36-37, WANG (example 1 and table 1) discloses a polymeric balloon of pebax (col. 5, lines 51) having substantial all structural limitation as recited in the claims, except

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for the balloon thickness in the range as claimed. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to make WANG balloon having a thickness in the range as recited in the claims for other applications requiring balloons with bigger sizes.

Response to Arguments

Applicant's arguments filed 7/2/2007 have been fully considered but they are not persuasive. As indicated above, the original specification has failed to specify the same inflation conditions between two phases of a balloon (after molding and in a catheter system). Indeed, the original specification as presented does not excludes the case of different inflation conditions of the balloon used for determination of the shrinkage percentage.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 571-272-4692. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



07/09/07

Vy Q. Bui
Primary Examiner
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